



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/551,174

09/29/2005

Takatoshi Hirose

00862.023671.

4239

5514

7590

09/28/2009

FITZPATRICK CELLA HARPER & SCINTO

1290 Avenue of the Americas

NEW YORK, NY 10104-3800

EXAMINER

MURRAY, DANIEL C

ART UNIT

PAPER NUMBER

2443

MAIL DATE

DELIVERY MODE

09/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,174	Applicant(s) HIROSE, TAKATOSHI	
	Examiner DANIEL C. MURRAY	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13JUL2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13JUL2009 has been entered.

Information Disclosure Statement

2. The information disclosure statement submitted on 13JUL2009 has been considered by the Examiner and made of record in the application.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: **Claim 11** lacks proper antecedent basis for the claimed terminology “computer-readable program codes”. There is an inconsistency between the amended portion of the specification (computer-executable program codes) and the amended **claim 11** (computer-readable program codes) submitted in the Response dated 13JUL2009.

Art Unit: 2443

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1, 3, 6-11, and 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asoh et al. (US Patent Publication # US 2004/0003060 A1)** in view of **Ohta (US Patent Publication # US 2001/0029531 A1)**.

a) Consider **claims 1, 10, and 11**, Asoh et al. clearly show and disclose, a connection control method for an information processing apparatus, information processing apparatus, and a computer-readable storage program product comprising a computer usable medium having computer-readable program codes control logic stored therein that, when executed by a computer, for causing a computer to control a connection of an information processing apparatus, wherein the control logic causes the computer to implement the method comprising: a reception step of receiving identification information for identifying a first wireless network and a second wireless network (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0015]); a first joining step of

Art Unit: 2443

wirelessly joining the first wireless network identified by the identification information received in the reception step (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0015]); and a second joining step of joining the second wireless network identified by the identification information received in the reception step, if no information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step (figure 4, figure 10, abstract, paragraph [0012], [0013], [0014], [0015], [0020], [0023]). However, Asoh et al. does not specifically disclose a first inquiry step of inquiring, of one or more information processing apparatuses in the first wireless network, whether the one or more information processing apparatuses are capable of performing a predetermined processing; a first detection step of detecting, based on a positive response to the inquiring in the first inquiry step, detecting an information processing apparatus capable of performing the predetermined processing in the first wireless network; a first request step of requesting the predetermined processing from the information processing apparatus in the first wireless network capable of performing the predetermined processing, if the information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step; a second inquiry step of inquiring, of one or more information processing apparatuses in the second wireless network, whether the one or more information processing apparatuses are capable of performing the predetermined processing, if no information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step; a second detection step of, based on a positive response to the inquiring in the second inquiry step, detecting an information processing apparatus capable of performing the predetermined processing in the second wireless network; or a second request step of requesting the predetermined processing from the information processing apparatus in the second wireless network

Art Unit: 2443

capable of performing the predetermined processing, if no information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step, wherein the first wireless network is different from the second wireless network.

Ohta shows and discloses printing at a convenient location, and more particularly related to a system for and method of printing information at a conveniently located printer station that is selected in a predetermined area wherein, Ohta clearly discloses a first inquiry step of inquiring, of one or more information processing apparatuses in the first wireless network, whether the one or more information processing apparatuses are capable of performing a predetermined processing (figure 13, abstract, paragraph [0007], [0040], [0053]); a first detection step of detecting, based on a positive response to the inquiring in the first inquiry step, detecting an information processing apparatus capable of performing the predetermined processing in the first wireless network (figure 13, abstract, paragraph [0007], [0040], [0053]); a first request step of requesting the predetermined processing from the information processing apparatus in the first wireless network capable of performing the predetermined processing, if the information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step (figure 13, abstract, paragraph [0007], [0040], [0053]); a second inquiry step of inquiring, of one or more information processing apparatuses in the second wireless network, whether the one or more information processing apparatuses are capable of performing the predetermined processing, if no information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step (figure 13, abstract, paragraph [0007], [0040], [0053]); a second detection step of, based on a positive response to the inquiring in the second inquiry step, detecting an information processing apparatus capable of performing the predetermined processing in the second wireless network (figure 13,

Art Unit: 2443

abstract, paragraph [0007], [0040], [0053]); and a second request step of requesting the predetermined processing from the information processing apparatus in the second wireless network capable of performing the predetermined processing, if no information processing apparatus capable of performing the predetermined processing in the first wireless network is detected in the first detection step, wherein the first wireless network is different from the second wireless network (figure 13, abstract, paragraph [0007], [0040], [0053]).

One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Ohta and Asoh et al. since both concern detection over wireless networks and as such, both are with in the same environment.

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate detecting a device on network capable of performing a predetermined process, as taught by, Ohta into the system of Asoh et al. for the purpose of locating a printer on a wireless network capable of performing a predetermined process (Ohta; abstract), thereby allowing the user to conveniently locate a device on the network of performing a predetermined process.

b) Consider **claim 3**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein, in the first request step, the predetermined processing is requested from another information processing apparatus that has first positively responded to the inquiring in the first inquiry step (Ohta; abstract, paragraph [0045]).

c) Consider **claim 6**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein in the first inquiry step, it is inquired whether all information processing apparatuses in the first wireless network are capable of performing the predetermined processing (Ohta; abstract, paragraph [0045]).

Art Unit: 2443

d) Consider **claim 7**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein the information processing apparatus wirelessly communicates according to a wireless LAN method defined by IEEE 802.11 (paragraph [0082]).

e) Consider **claim 8**, and **as applied to claim 7 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 7, wherein the information processing apparatus wirelessly communicates in a communication mode according to an infrastructure mode defined by IEEE 802.11 (paragraph [0082]).

f) Consider **claim 9**, and **as applied to claim 7 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 7, wherein the information processing apparatus wirelessly communicates in a communication mode according to an ad-hoc mode defined by IEEE 802.11 (paragraph [0082]).

g) Consider **claim 13**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1, wherein in the first request step, information processing apparatus capable of performing the predetermined processing is connected and the predetermined processing is requested (Ohta; figure 13, abstract, paragraph [0007], [0040], [0045], [0053]).

h) Consider **claim 14**, and **as applied to claim 13 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 13, wherein in the first request step, the predetermined processing requested from an information processing apparatus that has positively responded to the inquiring in the first inquiry step (Ohta; figure 13, abstract, paragraph [0007], [0040], [0045], [0053]).

Art Unit: 2443

7. **Claims 4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Asoh et al. (US Patent Publication # US 2004/0003060 A1)** in view of **Ohta (US Patent Publication # US 2001/0029531 A1)** and in further view of **Suda et al. (US Patent # 6,157,465)**.

a) Consider **claim 4**, and **as applied to claim 3 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 3. However, Asoh et al. as modified by Ohta does not specifically disclose in the first request step, when the predetermined processing performed by an information processing apparatus that has first positively responded to the inquiring in the first inquiry step ends as an error, the predetermined processing is requested from another information processing apparatus that has positively responded to the inquiring in the first inquiry step.

Suda et al. show and disclose a printer that is instructed to perform a printing job analyzes the job and determines a process to be executed, and identifies the performances of the printer and other printers and their states. Based on the results of the analysis and on the states of the printers, the printer decides whether it should not perform a process or whether the process should be performed by another printer. It also decides whether a process is unnecessary or is not permitted for a user, and halts the performance of such a process. When it determines that a process should be performed by another printer, it transfers the job to that printer, wherein in the first request step, when the predetermined processing performed by an information processing apparatus that has first positively responded to the inquiring in the first inquiry step ends as an error, the predetermined processing is requested from another information processing apparatus that has positively responded to the inquiring in the first inquiry step (column 20 lines 41-60, column 21 lines 27-37).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Suda et al. into the system of Asoh et al. as

Art Unit: 2443

modified by Ohta et al. for the purpose of transferring a job to another device if an error occurs in the device originally executing the job.

b) Consider **claim 5**, and **as applied to claim 1 above**, Asoh et al. as modified by Ohta clearly show and disclose, the method according to claim 1. However, Asoh et al. as modified by Ohta does not specifically disclose in the first inquiry step, when a response to the inquiring is a negative response or no response exists, it is determined that there is no information processing apparatus capable of performing the predetermined processing in the first wireless network.

Suda et al. show and disclose a printer that is instructed to perform a printing job analyzes the job and determines a process to be executed, and identifies the performances of the printer and other printers and their states. Based on the results of the analysis and on the states of the printers, the printer decides whether it should not perform a process or whether the process should be performed by another printer. It also decides whether a process is unnecessary or is not permitted for a user, and halts the performance of such a process. When it determines that a process should be performed by another printer, it transfers the job to that printer, wherein in the first inquiry step, when a response to the inquiring is a negative response or no response exists, it is determined that there is no information processing apparatus capable of performing the predetermined processing in the first wireless network (abstract, column 19 lines 52-64, column 20 lines 41-60).

Therefore, it would have been obvious to one of ordinary skill in the art that the time the invention was made to incorporate the teachings of Suda et al. into the system of Asoh et al. as modified by Ohta et al. for the purpose of locating a device capable of performing a predetermined process.

Response to Arguments

8. Applicant's arguments filed 13JUL2009 have been fully considered but they are not persuasive.

Applicant argues that “As best understood by Applicant, if the computer is used in the office and the office network is not detected, selecting the location name of "home" would not cause the computer to join the home network, because the home network would not be available to the computer when the computer is located in the office.”

The Examiner respectfully disagrees; Asoh clearly discloses detecting available networks (network adapters) is based on location. For example, if the user was in the “office” and the user were to select “office” from the list of location identifiers a list of available networks in the “office” would be displayed. The user would not be selecting “home” from the list of location identifiers while in the “office” in order to determine the available networks in the “office”. As a further example Asoh clearly discloses a user selecting a connection type (wireless) and location name (meeting room). Once the user has selected these items a list of usable network adapters (available networks) is displayed so that the adapters usable in that location are displayed such that the user is able to select one of the network adapters (networks)(figure 5, figure 6, paragraph [0066], [0067], [0068]). Asoh clearly discloses that once the location identifier is selected from the list the user is then able to select from a list available network adapters (networks) to connect to near-by networks (figure 4, figure 10, figure 12A, figure 12B, abstract, paragraph [0012], [0013], [0014], [0015], [0020], [0021], [0022], [0022]).

Applicant argues that “...nothing has been found in *Asoh et al.* that is believed to teach or suggest that computer joins the second network based on results of such detecting and inquiring.”

Art Unit: 2443

The Examiner respectfully disagrees; in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Asoh clearly discloses being able to select from a list of usable network adapters (available networks) is displayed so that the adapters usable in that location are displayed such that the user is able to select on of the network adapters (networks)(figure 4, figure 10, figure 12A, figure 12B, abstract, paragraph [0012], [0013], [0014], [0015], [0020], [0021], [0022], [0022]). Ohta clearly discloses inquiring of print stations in the wireless network whether the print stations are capable of performing a predetermined processing function (figure 13, abstract, paragraph [0007], [0040], [0053]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select a first network and search for a device capable of performing a predetermined processing function, and upon finding no device capable of performing a predefined processing function on the first network to the select another of the available networks and search for a device capable of performing a predetermined processing function on that network.

Applicant argues that “None of the information transmitted from the print stations is understood to indicate whether the print station is capable of performing a predetermined processing function. Accordingly, *Ohta* is not understood to teach or suggest inquiring of print stations in the wireless network whether the print stations are capable of performing a predetermined processing function.”

The Examiner respectfully disagrees; Ohta clearly discloses the information transmitted from the print stations is indicates whether the print station is capable of performing a predetermined processing function (figure 13, abstract, paragraph [0007], [0040], [0053]). Ohta clearly discloses the

Art Unit: 2443

print stations each send information on their printer characteristics such as availability status and print resolution to the portable digital device, a print server or a client that originated the print request. The recipient of the printer characteristic information selects an appropriate print station based upon a predetermined selection rule (abstract) and that the appropriate print station is determined by a number of criteria including the location of the print station in relation to the portable digital device 11 and the print parameters that are provided in the e-mail print notice. The print parameters include a type of printing such as color, a speed of the printer and a number of copies. Ohta clearly discloses the information transmitted from the print stations is indicates whether the print station is capable (availability status and print parameters) of performing a predetermined processing function (i.e. printing as required by the parameters of that particular print notice).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2009/0177801 A1
- US 7,523,212 B2
- US 2004/0102192 A1
- US 7,190,471 B2
- US 6,493,104 B1
- US 7,535,588 B2
- US 7,519,697 B2
- 5,699,495
- US 2003/0002073 A1
- US 2009/0025081 A1
- US 2006/0133414 A1

Art Unit: 2443

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MURRAY whose telephone number is 571-270-1773. The examiner can normally be reached on Monday - Friday 0800-1700 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571)-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DCM/

Examiner, Art Unit 2443

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443